



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND
INTERFERENCES

In re the Application of David M. Goldenberg

Serial No.: 09/313,278

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Docket No.: 41158-0003 US1

Examiner: Rimell, Samuel G.

For: VIRTUAL DOCTOR INTERACTIVE CYBERNET SYSTEM

BRIEF ON APPEAL (AMENDED)

Appeal from Art Unit 2164

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Appellant hereby appeals the final rejection of the above-identified application to the Board of Patent Appeals and Interferences.

I. REAL PARTY IN INTEREST

The real party in interest in this case is David M. Goldenberg, as this application has not been assigned to another entity.

II. RELATED APPEALS AND INTERFERENCES

Appellant and appellant's legal representatives are aware of no appeal or interference which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 39-51 are pending. Claims 39-51 stand finally rejected, as indicated by the Advisory Action mailed on May 24, 2004. All claim amendments have been entered into the record, and appellant's arguments after Final Rejection have been considered, as indicated in the May 24, 2004 Advisory Action.

A copy of the claims pending are provided at APPENDIX 1.

IV. STATUS OF AMENDMENTS

A final Office Action was issued on January 9, 2004. An Amendment and Request for Reconsideration under 37 C.F.R. § 1.116 was filed on May 10, 2004. In response, an Advisory Action issued on May 24, 2004 in which it was stated that the request for reconsideration was considered but did not place the application in condition for allowance. According to the Advisory Action, the Examiner rejected Applicant's argument that U.S. Patent No. 6,039,688 to Douglas et al. ("Douglas") fails to disclose the step of determining user sophistication. The Examiner maintains that a description in Douglas of determining points earned correlates to a determining of user sophistication. In the Advisory Action, the Examiner also rejected Applicant's assertion that claim 51 calls for remote surgery, not just the concept of

being referred for surgery. The Examiner instead maintained the position that the patient is a remote patient, not a local patient, and thus, any surgery performed on that patient would be remote surgery. The Examiner further asserted that any information signals sent to refer the patient for surgery at a remote location results in remote surgery.

Although not expressly indicated in the Advisory Action, form PTOL-303, Applicant understands the pending claims 39-51 to stand finally rejected in view of the Examiner's comments.

V. SUMMARY OF INVENTION

Independent claim 39 is directed to a method of providing one of the group consisting of medical, veterinary, and other health care information on subjects of interest to a user. The method comprises accepting an inquiry from the user, (*see as-filed specification pg. 9:2-3; FIG. 3, Ref. No. 301*), and determining a level of service based on the user inquiry. (*See as-filed specification pg. 9:5 to pg. 10: 1; FIG. 3, Ref. Nos. 302-311*) Where it has been determined that the level of service is a first level of service, the method further provides determining a user sophistication based on the user inquiry, (*see as-filed specification pg. 10:24 to pg. 11:14; FIG. 4; Ref. Nos. 401-407*). The method also includes searching a database at an initial level using the search request, in order to identify information requested in the user inquiry, and conditioning the search results based on the user sophistication. (*See as-filed specification pg. 11:14-16; FIG. 4, Ref. No. 408*). The method as claimed further includes providing the conditioned search results at the initial level to the user. (*See as-filed specification pg. 11:17-22; FIG. 4, Ref. No. 409-410*).

Dependent claim 51 is directed to the method of claim 39, described above and further comprises at least one of where if the level of service is a second level of service, the method includes searching the database at a subsequent level using the search request in order to identify more information requested in the user inquiry than in the initial level and providing the search results at the subsequent level to the user, (*see as-filed specification pg. 7:4-6; pg. 12:6-22; FIG. 5, Ref. Nos. 501-508, 517*), and where if the level of service is a third level of service, the method includes providing the user with a list of health care professionals conditioned based on the user

inquiry, and referring the user inquiry to a health care professional selected by the user. (*See as-filed specification pg. 7:15-28; pg. 13:14 to pg. 14:19; FIG. 6, Ref. Nos. 601-613*).

The method of dependent claim 51 at least includes where if the level of service is a fourth level of service, the method provides monitoring a physiological condition of the user relating to the user inquiry and administering treatment to the user. (*See as-filed specification pg. 7:29 to pg. 8:4; pg. 14:20 to pg. 19; FIG. 7, Ref. Nos. 701-708*). More specifically, administering treatment to the user comprises transmitting telemedicine signals over a network to perform remote surgery. (*See as-filed specification pg. 17:11 to pg. 18:13*).

VI. ISSUES

There are two primary issues for appeal in the present case:

First, claims 39-50 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. patent no. 6,039,688 to Douglas ("Douglas" hereafter). Appellant submits that Douglas fails to disclose or suggest all of the elements recited in claims 39-50 as required under 35 U.S.C. §102(e).

Second, claim 51 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Douglas in view of Official Notice. Appellant submits that there is no motivation to combine Douglas with the Official Notice taken in such a way as to disclose or suggest all of the elements recited in claim 51 as required under 35 U.S.C. §103(a).

VII. GROUPING OF CLAIMS

For purposes of the present appeal, the claims do not all stand or fall together, but will be argued separately according to the following groups:

Group 1 Claims 39-50

Group 2 Claim 51

Arguments supporting patentability of Group 1 are found in Section VIII.A of the Brief. Arguments demonstrating additional bases for patentability of Group 2 are presented in Section VIII.B of the Brief.

VIII. ARGUMENT

The rejections are based on the Examiner's unreasonable interpretation of the term "sophistication" as recited in the pending independent claims. In particular, the Examiner unreasonably interprets determining a user sophistication based on a user inquiry as reading on a reference which discloses a reward point system that tracks award points on a per user basis. Appellant respectfully submits that merely discerning between users on the basis of a login prompt and keeping separate records on a per user basis as disclosed in the cited art does not determine a user sophistication at all, and thus fails to disclose or suggest the claimed methods that condition search results based on the determined user sophistication. Appellant further submits that the cited art fails to teach or suggest the step of determining user sophistication based on a user inquiry as required by the instant claims, because the cited art does not determine a user sophistication at all.

Additionally, the Examiner has taken Official Notice that the concept of having a physician ask a patient to undergo surgery is very well known in the context of physician-patient information. However, no such element is recited in the pending claims, and thus the Official Notice fails to rectify an acknowledged deficiency in the cited prior art.

A. Claims 39-50

The claims under appeal require that a system accept a user inquiry followed by the step of "determining a user sophistication based on the user inquiry." In the Office Action of January 9, 2004 (the "Final Office Action" hereafter) the Examiner asserts that Douglas discloses "user sophistication" as "the number of points that the user earns for participating in the system. The system thus determines the user sophistication by keeping a record of the points for each use." See first full paragraph on pg. 3 of the Final Office Action. Appellant respectfully disagrees with this assertion.

Douglas is directed to a therapeutic behavior modification program having a series of milestones designed to encourage an individual to achieve lifestyle changes necessary to maintain health or to recover from ailments or medical procedures (see Abstract). As noted by the Office Action, Douglas discloses a rewards feature, where users earn points by good participation in the program and by reaching certain milestones (Douglas 14:42-44). For instance, points may be earned for good attendance at meetings, good participation during the meetings, chairing a meeting, or losing a certain amount of weight, if this was a goal to be accomplished (Douglas 14:44-47). The reward points can be cashed at the village store 78 for purchase of various items such as goods, frequent flier miles, or a symbolic reward (Douglas 19:1-2; claim 23).

Hence, while Douglas indeed discloses reward points tracked on a per user basis, these reward points, like any other form of currency, fail to provide any indication whatsoever of user *sophistication*. In other words, one cannot determine a user's sophistication merely by how many reward points the user earns. By way of example, assume two users: (1) an overweight doctor; and (2) an overweight truck driver. Clearly the doctor would be a more sophisticated user of a therapeutic program than the truck driver, as the doctor is able to understand detailed medical articles and research which the truck driver could not. This does not mean, however, that the doctor would be a more successful user of the program. If both the doctor and the truck driver have goals of losing 10 pounds, and they both achieve those goals, Douglas would reward them both by awarding them "reward points", say 10 reward points. Now we have two users both with 10 reward points, but these rewards points provide no basis whatsoever for distinguishing the relative sophistication of the doctor and the truck driver. Clearly, the level of reward provides no indication of the sophistication of the user. The claims under appeal require a determination of the sophistication of the user, whereas the methods allegedly taught by Douglas fail to describe any such determination. Accordingly, Douglas fails to disclose each and every element of the claimed invention and the rejection should be withdrawn.

Notwithstanding this, the Office Action mailed on May 24, 2004 (the "Advisory Action" hereafter) responded to this distinction by stating "Examiner maintains that determining points earned correlates to a determining of user sophistication, as stated in the final office action. Contrary to applicant's arguments, user sophistication does not necessarily imply educational level." Appellant respectfully submits that this statement is a *non sequitur*. Appellant agrees that user sophistication does not necessarily imply educational level. However, the Examiner's assertion mischaracterizes the disputed claim element, and results in the improper inference that determining points earned correlates to a determining of user sophistication.

The presently claimed invention is directed at providing an appropriate level of access to respond to a user inquiry (as-filed specification pg. 9:23-24; 10:10-12) based on (1) the *sophistication of the user's inquiry*; and/or (2) the *sophistication of the user* (as-filed specification pg. 10:4-7). The presently claimed invention does *not* recite (and Appellant does not assert that it recites) determining user access level from an *educational* level of a user as implied by the Final Office Action. Appellant claims user *sophistication*, not user *education*.

To illustrate, consider an individual who has suffered from epilepsy for years, who has a well developed knowledge of the disease, and who has remained informed on new and innovative treatment. This individual would be a sophisticated user in regards to inquiries involving epilepsy. If this user inquires about a new treatment using proper medical terminology in his/her inquiry, the system of the presently claimed invention would determine user sophistication *from the context of the user inquiry* (as-filed specification pg. 9:27-28). In other words, this user would be considered to be a sophisticated user. Thus, while education of the user may play a part in how the user frames his/her inquiry which could then be used in determining user sophistication, the *education* of the user is not itself of concern and does not control the final determination. Hence, the Examiner's interpretation of "sophistication" as presently recited in the pending independent claims is unreasonable in view of what one of ordinary skill would interpret sophistication to include.

Indeed, Douglas fails to disclose or suggest determining user sophistication at all. Rather, Douglas merely identifies the user in a login step described in col. 8:1-5. According to

Douglas, once the user has logged on, the user is matched up with that particular user's records on the system (see system setup described in col. 6:14-27). Such record keeping as described on pg. 3:5-6 of the Final Office Action never discerns user *sophistication* - it merely discerns users from one another.

As with Douglas, the present invention also discloses login and record keeping steps (see steps 303, 305 described in the as-filed specification pg. 9:9-14). Login and record keeping steps 303, 305 in the present invention, however, are wholly separate from determining a user sophistication based on the user inquiry in step 307, and they perform completely different functions. In particular, steps 303,305 discern between users. Step 307 determines the sophistication of the user. Thus, discerning users from one another, as disclosed by Douglas, is entirely different from determining user sophistication as claimed. Indeed if, as the Examiner asserts, determining a user's identity meets the definition of determining user sophistication, the step of determining user sophistication recited in the instant claims would be superfluous. This further illustrates the impropriety of the Examiner's argument. In sum, because Douglas fails to disclose or suggest determining a user sophistication as claimed, Douglas cannot anticipate the presently claimed invention.

Finally, the reward points described in Douglas (which the Examiner alleges are analogous to a determined user sophistication) are not used to condition search results as required by the instantly appealed claims. In particular, the reward points in Douglas are not used to condition search results from the village library 80. Rather, the reward points in Douglas are cashed in at the village store 78 for purchase of various items such as goods, frequent flier miles, or a symbolic reward (Douglas 19:1-2; claim 23). Hence Douglas also fails to disclose or suggest the step of conditioning search results based on the user sophistication as claimed. While Appellant provided this additional grounds for traversing Douglas in Appellant's reply of May 10, 2004, the Examiner failed to respond to it in the Advisory Action.

Thus, for at least the aforementioned reasons, Douglas fails to anticipate the presently claimed invention.

B. Claim 51

Separate from the aforementioned distinctions, the Office Action acknowledges that Douglas does not ask the user to undergo surgery as recited in claim 51. The Examiner takes Official Notice, however, that the concept of having a physician ask a patient to undergo surgery is very well known in the context of physician-patient information. Without acquiescing to the Examiner's assertion, Appellant respectfully pointed out that claim 51 recites transmitting telemedicine signals over a network to perform remote surgery. Hence, Appellant pointed out that claim 51 does not ask a patient to undergo surgery as recited in the Final Office Action - claim 51 affirmatively recites actually performing the surgery.

The Advisory Action responded to this distinction stating "[a]s stated in the final office action in association with claim 51, the patient is a remote patient, not a local patient. Thus any surgery performed on that patient would be remote surgery. Information signals sent to refer the patient for surgery at a remote location results in remote surgery." Appellant respectfully disagrees.

Simply being remote and having surgery recommended or conducted is not the equivalent of performing remote surgery as claimed. If a doctor in the United States diagnoses a medical condition on a soldier in Iraq and recommends amputation of the soldier's arm, the soldier's arm does not suddenly disappear upon diagnosis. It does not matter whether the diagnosis comes in an email, a telephone call, a facsimile, or any other communication method - the arm does not simply disappear *sua sponte*. Rather, the soldier must still go to a facility in Iraq to have his/her arm amputated by another doctor at the Iraqi facility. Thus, the doctor in the United States does not remotely perform the amputation on the soldier in a manner consistent with the claimed invention.

Moreover, simply because the soldier is located in Iraq, which is remote from the diagnosing doctor in the United States, this does not mean that remote surgery occurs when the soldier goes to an Iraqi facility to have his/her arm amputated. This surgery is face-to-face between the soldier in the Iraqi facility and the treating doctor in the Iraqi facility. Direct, in

person contact between the patient and treating doctor is not "remote", and thus is not "remote surgery" as claimed and readily understood by those of skill in the art.

As such, the Official Notice taken by the Examiner fails to rectify the acknowledged deficiency in Douglas.

For at least these reasons, the Board is respectfully requested to reverse the Examiner and remand this application for issuance.

Respectfully submitted,

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IX. APPENDIX

Claims 1-38 (Cancelled).

39. (Previously Presented) A method of providing one of the group consisting of medical, veterinary, and other health care information on subjects of interest to a user, the method comprising:

accepting an inquiry from the user;

determining a level of service based on the user inquiry; and

if the level of service is a first level of service:

determining a user sophistication based on the user inquiry;

searching a database at an initial level using the search request, in order to identify information requested in the user inquiry;

conditioning the search results based on the user sophistication; and

providing the conditioned search results at the initial level to the user.

40. (Previously Presented) The method of claim 39, further comprising at least one of:

(A) if the level of service is a second level of service:

searching the database at a subsequent level using the search request, in order to identify more information requested in the user inquiry than in the initial level; and

providing the search results at the subsequent level to the user;

- (B) if the level of service is a third level of service:

providing the user with a list of health care professionals conditioned based on the user inquiry; and

referring the user inquiry to a health care professional selected by the user;

- (C) if the level of service is a fourth level of service:

monitoring a physiological condition of the user relating to the user inquiry; and

administering treatment to the user.

41. (Previously Presented) The method of claim 40, wherein the method includes at least (A).

42. (Previously Presented) The method of claim 41, wherein the method includes at least (B).

43. (Previously Presented), the method of claim 42, wherein the method includes at least (C).

44. (Previously Presented) The method of claim 43,

wherein the first level of service is performed before the second level of service,

wherein the second level of service is performed before the third level of service, and

wherein the third level of service is performed before the fourth level of service.

45. (Previously Presented) The method of claim 41, wherein the method includes at least (C).

46. (Previously Presented) The method of claim 40, wherein the method includes at least (B).

47. (Previously Presented) The method of claim 46, wherein the method includes at least (C).

48. (Previously Presented) The method of claim 46, wherein the third level of service further comprises:

accepting preferences, from the user, regarding health care professionals;

creating a weighing function to rank order health care professionals; and

accepting a selection, from the user, of the health care professional.

49. (Previously Presented) The method of claim 40, wherein the method includes at least (C).

50. (Previously Presented) The method of claim 49, wherein administering treatment to the user comprises transmitting telemedicine signals over a network to effect the release of a chemical or drug into the user through an implanted device.

51. (Previously Presented) The method of claim 49, wherein administering treatment to the user comprises transmitting telemedicine signals over a network to perform remote surgery.

Claims 52-64 (Cancelled).